

TRANSMITTAL OF APPEAL BRIEF (Small Entity)Docket No.
98-092In Re Application Of: **JAY S. WALKER et al.**Serial No.
09/267,489Filing Date
March 11, 1999Examiner
James A. ReaganGroup Art Unit
3621

Invention:

SYSTEM AND METHOD FOR MAILING LIST TESTING SERVICE**TO THE COMMISSIONER FOR PATENTS:**Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
September 4, 2002


Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application, and Appeal Brief Fee of \$165.00 was paid September 11, 2003

The fee for filing this Appeal Brief is:

- ☐ A check in the amount of the fee is enclosed.
- ☒ The Director has already been authorized to charge fees in this application to a Deposit Account.
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Magdalena M. Fincham
Attorney for Applicants
PTO Registration No. 46,085
Walker Digital, LLC
203.461.7041/phone
203.461.7300/fax

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Applicant(s): JAY S. WALKER et al.			
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jay S. Walker, Magdalena Mik
Fincham, Daniel E. Tedesco, and Dean
Alderucci

Application No.: 09/267,489

Filed: March 11, 1999

For: SYSTEM AND METHOD FOR
MAILING LIST TESTING SERVICE

)
) Group Art Unit: 3621

)
) Examiner: James A. Reagan

)
) **SUPPLEMENTAL APPEAL BRIEF**
) **(Replaces the previous Appeal Brief in**
) **its entirety - no reference is made to the**
) **previous Appeal Brief)**

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) Attorney Docket No. 98-092

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Dated: February 27, 2004 By:

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Dear Examiner:

Appellants hereby request reinstatement of the appeal to the Board of Patent
Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed
December 11, 2002 (Paper No. 18), rejecting claims 1 - 50.

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APPENDIX A: CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL

APPENDIX B: CHART SHOWING CLAIM DEPENDENCIES

REAL PARTY IN INTEREST

The present application is assigned to Walker Digital, LLC, 1177 High Ridge Road, Stamford, CT 06905.

RELATED APPEALS AND INTERFERENCES

Appellants are not aware of any other appeals which might be considered to directly affect, be directly affected by or have a bearing on the Board's decision in the pending appeal:

STATUS OF CLAIMS

Claims 1 - 50 are pending in the present application and are being appealed.

Claims 5- 7, 18 – 20, 31- 34, 43, 45 and 46 stand objected to as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1 – 4, 8 – 12, 14 – 17, 21 – 25, 27 – 30, 35 – 42, 44 and 47 – 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of:

- Druckenmiller;
- Interactive Marketing News; and
- “Applicant's Admissions”.

Claims 13 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over a combination of:

- Druckenmiller;
- Interactive Marketing News; and
- U.S. Patent No. 6,292,785 to McEvoy.

STATUS OF AMENDMENTS

No amendments were filed subsequent to final rejection.

SUMMARY OF INVENTION

Generally, according to one aspect of the invention, a method for providing a service for testing a postal mailing list is disclosed. This mailing list test service tests a plurality of mailing lists by using e-mail messages. A purpose of the test is to determine which of the plurality of available postal mailing lists is expected to have the best response (*e.g.*, highest response rate and / or most favorable responses) to a planned postal mailing. To perform the test, a computer-based message, such as an electronic mailing (e-mail), is sent to each of a subset of list members for each postal mailing list. Based on the received responses to the test e-mails, one of the postal mailing lists is selected for use in a postal mailing campaign. Present Application, page 3, lines 8 – 14 of the Present Application.

For example, a response rate is determined for each subset of postal mailing list members (each subset corresponding to a particular one of the plurality of postal mailing lists that is being tested). The postal mailing list corresponding to the subset having the highest response rate may then be selected. Present Application, page 14, line 31 – page 15, line 1). A postal mailing may then be sent to the members of the selected list, on the assumption that the response rate to the test e-mail is a reliable predictor of the response rate to the postal mailing. Present Application, page 4, lines 24 – 25.

One purpose of the test service is to “pre-test” the effectiveness of the postal mailing lists. Present Application, page 4, lines 22 – 23. In one contextual example of the invention, consider an author who has published a book on a niche subject (*e.g.*, cryptography) and wishes to buy or rent a postal mailing list to promote sales of the book. Rather than spending a substantial amount of money on a mailing list without any indication of its effectiveness for the author’s particular purpose, the author decides to “pre-test” several possible postal mailing lists. The author picks lists A, B, C, and D to pretest. A subset of individuals from each list is selected. A test e-mail is sent to these individuals, in which the e-mail contains, *e.g.*, an offer for a free newsletter on cryptography written by the author. The response rate (*i.e.*, the number of people accepting the offer) of each mailing list is then compiled and the list with the highest response rate is chosen as the best one to be purchased/rented by the author. Present Application, page 5, lines 9 – 17.

ISSUES

Whether claims **1 – 4, 8 – 12, 14 – 17, 21 – 25, 27 – 30, 35 – 42, 44 and 47 – 50** are unpatentable under 35 U.S.C. § 103(a) as being obvious in light of a combination of Druckenmiller, Interactive Marketing News, and Applicant's Admissions.

Whether claims **13 and 26** are unpatentable under 35 U.S.C. § 103(a) as being obvious in light of a combination of Druckenmiller, Interactive Marketing News, and McEvoy.

GROUPING OF CLAIMS

The claims in different groups do not stand and fall together.

Appellants group the pending claims as follows:

Group I - claims **1 – 3, 9, 10, 12, 14 – 16, 25, 27 – 29, 36, 37, 39, 40, 41, 44, 48 and 49;**

Group II – claims **11, 21, 24, 38 and 50;**

Group III – claims **4, 17, 30, and 42;**

Group IV – claims **13 and 26;**

Group V – claims **8, 22, 23, 35, and 47;** and

Group VI – claims **5 – 7, 18 – 20, 31 – 34, 43, 45 and 46.**

Appellants believe that claims in different groups are separately patentable, as explained below.

ARGUMENT

As explained below, the Examiner's rejection of the claims is improper at least because the Examiner has failed to set forth the required *prima facie* case of unpatentability of any claim. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references of record, alone or in combination. Further, various rejections are based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Moreover, regardless of the failure to present a *prima facie* case, the cited references, whether alone or in any combination, cannot be interpreted in a manner that would render any pending claim obvious.

Accordingly, the rejections are inappropriate and Appellants respectfully request that the Examiner's rejections be reversed.

In the arguments herein, limitations of the claims are indicated in *italics*, and the references of record are indicated by underlining.

In separate arguments of patentability of different Groups, Appellants have, where possible, referred to prior arguments to avoid undue repetition.

Reference is made in the arguments below to:

the "Third Office Action" (final Office Action mailed December 11, 2002); and
the "Fourth Office Action" (non-final Office Action mailed January 08, 2004, re-opening prosecution subsequent to appeal in order to allow some claims and modify basis of rejection for other claims).

THE REFERENCES

The Examiner has relied on a combination of references in the rejection of all claims. However, the references cited by the Examiner, either alone or in combination, do not disclose or suggest all of the limitations of any claim.

Discussed immediately below are the references used in rejecting the appealed claims:
Druckenmiller, Interactive Marketing News, Applicant's Admissions, and McEvoy.

The Druckenmiller patent

In summary, Druckenmiller discloses a method and system for generating electronic mail subscription lists. Abstract. The subscription list is generated such that it includes only individuals who have twice indicated a desire to be included on the subscription list, referred to as a Double Opt-in™ method and system. Column 2, line 1. A party interested in placing their e-mail address on a mailing list accesses an electronic bulletin board or Internet site and voluntarily subscribes to one or more electronic mailing lists by entering their e-mail address and selecting one or more subject areas of interest. Once a subscription request is received, a unique alphanumeric token is generated and associated with the e-mail address. An automated verification message is generated and sent to the entered e-mail address to confirm the subscription. The message indicates that a subscription request has been received and contains the unique token. The subscription is not considered valid until confirmed by a response that contains both the e-mail address and the associated unique token. When a response containing both the subscribed e-mail and the unique token is received, the subscription is confirmed and the subscriber information is added to the appropriate subscription lists. If a confirmation response is not received the subscription is considered invalid and the e-mail address is not added to any subscription lists. Column 2, lines 2 – 26.

A stated object of the invention is to provide a system and method by which a subscription address list may be generated with the assurance that substantially all of the listed addresses represent individuals who have voluntarily signed up to receive messages related to particular topics. Column 1, lines 54 – 59. Thus, the subscription lists generated according to the Double Opt-in™ method and system are presented as being very reliable and unlikely to contain any involuntary entries. Column 2, lines 32 – 35.

The Interactive Marketing News publication

In summary, Interactive Marketing News is an article that briefly describes, for use by website merchants, various methods for generating leads from a website with whom the

merchant can follow-up to close a sale. The various methods briefly described include: (i) signing up users for an electronic newsletter (which allows the merchant to ask a potential customer for their e-mail address and some marketing questions); (ii) holding contests (which allows the merchant to require contestants to enter their e-mail or postal mailing address and answer some marketing questions); (iii) offer potential customer free products or services (such as a catalog or trial subscription to a magazine, which again allows the merchant to obtain contact information for the potential customer); and (iv) conducting surveys about topics the merchant's customers are particularly passionate about (and, again, requesting the survey respondents to provide their e-mail address or other contact information). The article also encourages merchants, when gathering information from potential customers, to include fields that allow the potential customers to request to be put on the merchant's postal mailing list and to receive the merchant's e-mail newsletter.

Applicant's Admissions

In summary, Appellants have stated in the Present Application that a mailing list may be purchased or rented by a business. Present Application, page 2, line 8 – 10. Additionally, Appellants have stated in the Present Application that a mailing list may be used to “mail promotional items such as brochures, advertisements, or sales offers to persons included on the list.” Present Application, page 1, line 29 through page 2, line 1.

The McEvoy patent

In summary, McEvoy discloses a system and method for using a mailing label to be applied to magazines, newspapers, circulars or other mass mailing items. The label has included on it a subscriber's name and address. The label also has included on it a corporate logo or other advertising, marketing, or promotional information for a product. The label can be removed from the mailed item and applied to a coupon for retail redemption or to a return mailer, so that the subscriber information can be extracted from the coupon or return mailer, and used to generate a database of computer records forming a mailing list of desirable, motivated customers for the product promoted on the label. Abstract. In other words, a person may receive the label in the mail along with a coupon. In order to activate the coupon, the person is requested to apply

the label to the coupon. The label includes the person's name and address as well as an advertisement for a product. Thus, when the person redeems the coupon, the information from the label on the redeemed coupon may be extracted and the person's name and address added to a mailing list of persons who may be interested in the product advertised on the coupon.

Other Subject Matter Without Support in the Record is not Substantial Evidence

Appellants have already disputed all of the various assertions in the Office Action mailed June 05, 2002 (Paper No. 11) regarding what is 'well known' but lacked evidence of such subject matter in the record. Appellants Response mailed October 30, 2002, page 10, paragraph 3.

Appellants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. The references of record do not support the Examiner's broad assertions as to what was well known. At best, the prior art of record shows that only a very limited form of the asserted matter was known.

Accordingly, the Examiner's sweeping assertions which are not supported by the references of record lack substantial evidence, and therefore cannot be used as prior art to the present application. Only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, too the extent such extra-record assertions might be deemed official notice, officially-noted subject matter cannot be used as the **basis** for a rejection under Sections 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference** teaching.") (emphasis added).

In other words, official notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology

must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added); *In re Eynde*, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice.**") (emphasis added); *In re Pardo*, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art") (emphasis added)

1. Group I

Group I includes independent claims **1, 14, 27, and 39** and dependent claims **2, 3, 9, 10, 12, 15, 16, 25, 28, 29, 36, 37, 40, 41, 44, 48, and 49**.

Since all independent claims are included in Group I, the patentability of the claims of Group I renders all claims of all other groups patentable as well.

As discussed below, the rejection of the claims of Group I is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group I. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group I can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group I obvious.

1.1. Independent Claims 1, 14, 27, and 39

Independent claim 1 is directed to a method for providing a mailing list test service involving a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member. The method comprises sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members.

A plurality of responses are received, each received response corresponding to an e-mail message sent to each of the subset of list members. Each of the received responses is associated with a list member from one of the subsets of list members. One of the plurality of postal mailing lists is then selected for use based on the responses received in the previous step.

Group I

Independent claim 14 is directed to an apparatus, and includes a processor operative to perform a method substantially as described above with respect to method claim 1.

Independent claim 27 is directed to a medium storing instructions adapted to be executed by a processor, the instructions comprising instructions for carrying out a method substantially as described above with respect to method claim 1.

Independent claim 39 is directed to a system, the system comprising various means for carrying out functions generally as described above with respect to method claim 1.

For brevity, the discussion below refers to method claim 1, but the arguments are likewise applicable to claims 2, 3, 9, 10, 12, 14 – 16, 25, 27 – 29, 36, 37, 39 – 41, 44, 48 and 49.

1.2. Advantages of Independent Claim 1

The embodiment of claim 1 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages render the claimed subject matter nonobvious over the cited art.

By, sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members, before the step of selecting one of the plurality of postal mailing lists for use, a relatively fast and accurate predictor of how the totality of members of each list would react to a planned postal mailing may be gauged.

In accordance with one embodiment, by sending the e-mail to a subset of list members of each list, rather than to all of the members of each list, avoidance of (in accordance with one embodiment) an unduly large number of e-mail responses that need to be tracked while at the same time providing a sample analysis of the responses from each list that can be compared to the sample responses from the remainder of the plurality of postal mailing lists that are being tested may be realized.

As discussed in the present application, *selecting for use, based on responses to an e-mail message sent to a plurality of subsets of list members..., one of the plurality of postal mailing lists* allows a business that is contemplating purchase or rental of a postal mailing list to select, based on relevant data, the postal mailing list that is expected to elicit the highest or most

Group I

favorable response to the business's planned postal mailing. The embodiment of claim 1 can thus allow a business to quickly, efficiently, and cost-effectively determine an expected response to a planned postal mailing. Thus the business may select the postal mailing list that is expected to have the highest or most favorable response to the planned postal mailing. For example, selecting a postal mailing list based on results of a test as recited in claim 1 inexpensively injects a substantial amount of confidence into a business's selection of a postal mailing list for use. Postal mailing lists may be selected based on responses to, *e.g.*, a particular targeted questions, not merely on past postal mailing list response rates.

Thus, the embodiment of claim 1 allows a business to realize the benefits of using a postal mailing list (*e.g.*, higher responsiveness to certain types of direct mail if it is delivered through postal mail rather than e-mail) and to maximize those benefits by "pre-test"ing a plurality of postal mailing lists before selecting one for use, without incurring any substantial costs. A business can "pre-test" the expected responsiveness of members of a postal mailing list by using the inexpensive method of sending e-mail messages to the members.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

1.3. No Prima Facie Showing of Unpatentability of the Claims of Group I

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

The Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial

Group I

stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). The secondary considerations are also essential components of the obviousness determination. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

When a rejection is based on a combination of references, the Examiner can satisfy the prima facie burden only by showing some objective teaching leading to the purported combination of references. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Lacking a motivation to combine references, there is no prima facie case of obviousness. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

Finally, during examination, claims are given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367 (Fed. Cir. 2000). The "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

In general, the references clearly fail to suggest selecting a mailing list from a plurality of mailing lists (whether it be a postal mailing list from a plurality of postal mailing lists, as claimed, or even an e-mail mailing list from a plurality of e-mail mailing lists). The references certainly fail to suggest the particularly claimed method of how to select a postal mailing list from a plurality of postal mailing lists, which is doing so based on responses to an e-mail message. The references further fail to suggest sending an e-mail message, for each of a plurality of mailing lists, to each of a subset of the list members of any kind of mailing list, much less sending the e-mail message to subsets of postal mailing list members.

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1.3.1. No showing that the references suggest *selecting for use a postal mailing list from a plurality of postal mailing lists*.

The Examiner has not even shown that the references, alone or in combination, disclose or suggest

selecting a postal mailing list from a plurality of postal mailing lists,
much less

selecting for use a postal mailing list from a plurality of postal mailing lists based on responses to an e-mail message

much less the limitation of claim 1:

selecting for use one of the postal mailing list from the plurality of postal mailing lists based on responses to an e-mail message that was sent, for each postal mailing list in the plurality of postal mailing lists, to each of a subset of list members.

None of the prior art relied upon by Examiner teaches **any** method of how to select a postal mailing list from a plurality of available postal mailing lists, much less the particular method step of claim 1. Examiner has failed to assert that the prior art teaches such a limitation.

The Examiner has merely asserted the following in support of the §103(a) rejection of claim 1, though the assertions do not address the particular limitations of claim 1:

(i) Druckenmiller discloses “sending an automated verification email message to the mailing list member and receiving a response from the member (column 2, lines 10 – 19)” (bottom of page. 4 in the Third Office Action; bottom of page 3 in the Fourth Office Action);

(ii) Druckenmiller discloses “selecting a mailing list from a plurality of mailing lists according to a demographic, product, service, or other relevant subject (column 1, lines 14 – 15)” (top of page 5 in the Third Office Action; top of page 4 in the Fourth Office Action);

(iii) although Druckenmiller “does not specifically disclose a postal mailing address....Druckenmiller, in column 7, lines 18 – 22 discloses ‘demographic information for the subscribers may also be contained within each mailing list. Such demographic information may then be used to select only specific subscribers to a list according to various requirements.’ It would have been obvious...to use the demographic of a postal mailing address as a selection

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device for identifying possible mail recipients” (middle of page 5 in the Third Office Action; middle of page 4 in the Fourth Office Action);

(iv) although Druckenmiller “does not specifically disclose sending an email message to the member on the list...[Interactive Marketing News] discloses using postal address mailing lists, sending a questionnaire that includes postal mailing address fields and email address fields, asking recipients to submit their email address, and if they would like to be added to the mailing list. Naturally, if a recipient responds with correct or updated contact information, either by email or by postal mail, the recipient can be regarded as a verified lead. It would have been obvious...to combine the invention of Druckenmiller with [Interactive Marketing News] because using email to verify postal addresses and to further target recipients provides good leads and increases potential profitability” (bottom of page 5 through top of page 6 in the Third Office Action; bottom of page 4 through top of page 5 in the Fourth Office Action); and

(v) “Applicant readily admits that choosing a proper mailing list is crucial (see specification, pages 1 – 3). Basing that choice on the responses from an email sent out to each member on the list for verification and confirmation of accurate mailing data would be an obvious modification of Druckenmiller and [Interactive Marketing News] because, as disclosed by the Applicant, ‘It is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in the times the response as the worst list for an identical mailing piece.’” (middle of page 5 in the Fourth Office Action).

In listing the above assertions of what the prior art allegedly discloses, Examiner does not in any instance tie any of the assertions about what the prior art discloses to a particular claim limitation. In fact, Examiner does not address, but has apparently ignored, the claim limitations when discussing the above assertions. Further, Examiner does not address the particular limitations of claim 1 at all, even outside of the discussion of what the prior art discloses. In particular, Examiner does not assert that the prior art suggests, alone or in combination, *selecting for use a postal mailing list from a plurality of postal mailing lists based on responses to an e-mail message, where the e-mail message had previously been sent, for each of the plurality of postal mailing lists, to each of a subset of the list members*. For example, there is no discussion in the rejection of claim 1 why it would be obvious to use e-mail messages to “pre-test” the *Group I*

effectiveness of postal mailing lists, even though the genres of e-mail mailing lists and postal mailing lists were considered separate fields with no consistent and reliable correlations between postal mailing addresses and e-mail addresses of recipients of a single list prior to Appellants' invention.

Regarding assertion (i), Examiner has merely asserted that Druckenmiller discloses sending an e-mail to a member of an e-mail mailing list and receiving a response to that e-mail. However, Examiner does not address, in this or any of the other assertions supporting the rejection of claim 1, the actual claim limitation, which recites that an e-mail message is sent not just to a list member, but is *sent, for each of a plurality of postal mailing lists, to each of a subset of list members*. In particular, Examiner does not address whether the prior art teaches sending an e-mail message to a member of a *postal mailing list* and Examiner does not address whether the prior art teaches sending the e-mail message *for each of a plurality of postal mailing lists, to each of a subset of list members*.

Assertion (ii) addresses in general the selection of a mailing list. However, the passage of Druckenmiller that Examiner relies on for this assertion, as well as the remainder of Druckenmiller, merely describes selecting which list to add a recipient's name to. A name is added based on the topics that the recipient indicated an interest in. However, the selecting of a list described by Druckenmiller is not *selecting for use a postal mailing list from a plurality of postal mailing lists* but rather comprises selecting a mailing list to which the recipient's name is to be added.

Further, this selection of which list to add the recipient's name to is not done based on *responses to an e-mail message that was sent, for each postal mailing list in a plurality of postal mailing lists, to each of a subset of list members*. Rather, the selection is done based on information in a form that the recipient fills out. Examiner has not even asserted that the selection in Druckenmiller is based on the claimed factor, and has not asserted that any of the other prior art of record discloses or suggests such the claimed factor (*i.e.*, received responses to an e-mail message, where the e-mail message had previously been sent, for each of the plurality of postal mailing lists, to each of a subset of list members).

Regarding assertion (iii), Examiner is merely stating that certain information (*e.g.*, demographic information, which may include a postal address) may be used to select certain

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recipients who are included on a mailing list. From this assertion, Appellants assume that Examiner is referring to a practice where, for example, only those recipients on a mailing list that meet certain criteria (*e.g.*, live within a certain zip code) may be selected to receive a mailing.

First, Druckenmiller does not disclose such a practice and Examiner has not provided any reasoning or motivation of why one of ordinary skill in the art would have modified Druckenmiller to include such a practice.

Second, regardless of whether Druckenmiller discloses or suggests what is asserted, this assertion is not relevant to the claim limitations. Claim 1 does not recite a step of “selecting recipients to be included in a mailing list.” Claim 1 recites *selecting...a postal mailing list from a plurality of postal mailing lists*. Further, the selection (of a postal mailing list from a plurality of postal mailing lists) in claim 1 is done *based on responses to an e-mail message, wherein the e-mail message had previously been sent, for each of a plurality of postal mailing lists, to each of a subset of list members*. A postal mailing address or other demographic information has nothing at all to do with any selection performed in claim 1.

Further, Examiner has continued to discuss “selecting specific mail recipients to be included on a list”. However, in claim 1 a plurality of postal mailing lists are already in existence and claim 1 may be used in choosing amongst this plurality of available and existing postal mailing lists. Clearly, this has nothing to do with determining which recipients to add to a list. Accordingly, assertion (iii) appears to be unrelated to any of the limitations of claim 1. Appellants note that Examiner has not referred to any method of selecting a mailing list (whether it be a postal mailing list or an e-mail mailing list) from a plurality of mailing lists, much less based on any factor, much less based on the particular factor recited in claim 1.

Regarding assertion (iv), Examiner has merely stated that the prior art discloses that a business may create a list of leads which includes both an e-mail address and a postal address for some leads, and that an email may be sent to a lead asking the lead to confirm the postal mailing address of the lead. This is false.

First, Interactive Marketing News does not disclose sending an e-mail message to a potential lead that requests that the potential lead verify a postal mailing address.

Second, regardless of whether Interactive Marketing News discloses or suggests what is asserted, the assertion is not relevant to the limitations of claim 1. Interactive Marketing News

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does not disclose selecting a postal mailing list from a plurality of postal mailing lists, based on responses to an e-mail or otherwise and Examiner does not assert that Interactive Marketing News either suggests this or can be modified to suggest this feature.

The most that can be derived from assertion (iv) is that both an e-mail address and a postal mailing address may be obtained for a member of a mailing list, and that the business utilizing the mailing list may subsequently either e-mail information to the list member using the e-mail address or send information via postal mail. However, there is no disclosure or suggestion in the reference, nor an assertion made by Examiner, that this information can be used *to select for use a postal mailing list from a plurality of postal mailing lists by sending, for each of the plurality of postal mailing lists, an e-mail message to each of a subset of list members, and selecting the postal mailing list based on the responses received.*

Regarding assertion (v), the Examiner is merely asserting that Appellants recognized a problem in the prior art and discussed that problem in the specification. The Examiner's assertion does not even attempt to assert that Applicant's Admissions teach that the limitations of claim 1 were known in the prior art. Nothing in Applicant's Admissions discloses the limitation *of select for use a postal mailing list from a plurality of postal mailing lists by sending, for each of the plurality of postal mailing lists, an e-mail message to each of a subset of list members, and selecting the postal mailing list based on the responses received.* Appellants merely acknowledged that the selection of a postal mailing list is important to whether a postal marketing campaign will be successful. Appellants went on to discuss that the methods of selecting a postal mailing list, known in the prior art before Appellants' invention, were inadequate. Appellants' solution – *selecting a postal mailing list based on responses to an e-mail message that is sent, for each of a plurality of postal mailing lists to each of a subset of list members*, was not known in the prior art and Appellants never admitted that it was. The Examiner does not even attempt to assert that the particular limitation of claim 1 was known or admitted to be known by Appellants. Instead, the Examiner appears to be basing the rejection on the fact that Appellants discussed in the specification how the method of claim 1 solve an existing problem in the prior art and why the method of claim 1 would be useful. Appellants fail to see how acknowledging that a problem exists and is inadequately addressed in the prior art renders the inventive solution admitted or known.

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Further, as will be discussed further below, the Examiner's assertion (v) is utterly devoid of any motivation that would have caused one of ordinary skill in the art to combine Applicant's Admissions with Interactive Marketing News.

Putting all of Examiner's assertions together, regardless of their accuracy, one still does not obtain selecting a postal mailing list from a plurality of postal mailing lists, much less the step of claim 1 of *selecting for use a postal mailing list from a plurality of postal mailing lists, based on responses to an e-mail message that was sent to, for each of the plurality of postal mailing lists, a subset of the list members*. The most that can be derived from combining all of the Examiner's assertions is that a mailing list may include both a postal mail address and an e-mail address for some members of the list, that the e-mail address can be used to send e-mail messages to the members, the e-mail messages may request that the member verify their postal address, and that a postal address may be used as a factor for selecting whether a member should be included on a mailing list. When combined, the various assertions do not even address the above claim limitation. In fact, the prior art fails to teach or suggest the claim limitations. Further, the Examiner's assertions about what the prior art does teach are completely devoid of any reasoning of how the prior art may be modified or combined such that it teaches or suggests all of the limitations of claim 1.

Official Notice

In addition to the above assertions, Examiner appears to also be justifying the rejection of claim 1 with what appears to be Official Notice that "the selection of the most accurate, most valuable, and most recent mailing lists is obvious to any organization that intends to increase profitability by direct or electronic mailing to selected recipients...it is not only obvious but also inherent to the profitable company to select mailing lists that are current and verified...effective mailing lists are more valuable than old, untested lists." (only full paragraph on page 3 of the Third Office Action). The above assertions were not made as part of the rejection of claim 1, but rather in Examiner's reply to Appellants' arguments that the prior art does not teach or suggest the claim limitations of claim 1. Accordingly, it is unclear to what extent Examiner is relying on the above statements in the rejection of claim 1.

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However, to the extent that Examiner is relying on the above assertions, the record does not provide any support for these assertions. Further, the above assertions (even when combined with all of the assertions Examiner made about what the prior art discloses) still do not suggest the claim limitation of *selecting for use, based on responses received to an e-mail message, [the e-mail message having previously been sent, for each postal mailing list in a plurality of postal mailing lists, to each of a subset of list member], one of the plurality of postal mailing lists.*

Thus, in summary, the Examiner has not shown that the references, alone or in combination, suggest *selecting for use a postal mailing list from a plurality of postal mailing lists based on responses [to an e-mail, where the e-mail had previously been sent, for each of the plurality of postal mailing lists, to a subset of list members].*

Further, Applicants dispute that it is well known to test lists, which Examiner has asserted in the above statement is known. As stated throughout the present argument and in the Affidavit of Jay S. Walker (submitted herewith), prior to Applicants' claimed invention it was unknown to test the effectiveness of mailing lists in any way.

1.3.2. No showing that the references suggest *sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members.*

The Examiner has not shown that the references, alone or in combination, suggest *sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members.* The closest the Examiner comes is the statement made in assertion (i) recited in section 1.3.1, that Druckenmiller discloses "sending an automated verification email message to the mailing list member and receiving a response from the member (column 2, lines 10 – 19)." In Druckenmiller an e-mail message is not ever *sent, for each of a plurality of postal mailing lists* (or for each of a plurality of e-mail mailing lists for that matter), *to each of a subset of list members.* Druckenmiller lacks any hint of the claimed feature. An e-mail message is sent to a recipient in Druckenmiller in only two contexts: (1) a verification e-mail is sent to a recipient after the recipient first signs up for a mailing list, confirming the recipient's interest in being added to a mailing list, and (2) once a recipient is added to a mailing list, the mailing list is used to send information to each of the members of the list.

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In context (1), the e-mail message is not even sent to a single member of a mailing list, since the verification message is sent to a person who has not yet been added to a mailing list but who has merely expressed an interest in being added to a mailing list. In context (2), the e-mail message is certainly not sent to each of a subset of members for a **plurality** of mailing lists. None of the other prior art of record, alone or in combination, teaches or suggests *sending, for each of the plurality of postal mailing lists, an e-mail message to each of a subset of list members* for any purpose. The Examiner's reasoning is completely devoid of any assertion that the prior art teaches or suggests the claimed feature, or how the prior art may be modified or combined to teach or suggest the claimed feature. In fact, Examiner's discussion in support of the rejection of claim 1 completely ignores this claim feature or whether the prior art suggests this claim feature.

Again, regarding assertion (i) (quoted in Section 1.3.1), Examiner has merely asserted that Druckenmiller discloses sending an e-mail to a member of an e-mail mailing list and receiving a response to that e-mail. However, Examiner does not address, in this or any of the other assertions supporting the rejection of claim 1, the actual claim limitation, which recites that an e-mail message is sent not just to a list member, but is *sent, for each of a plurality of postal mailing lists, to each of a subset of list members*. In particular, Examiner does not address whether the prior art teaches sending an e-mail message to a member of a *postal mailing list* and Examiner does not address whether the prior art teaches sending the e-mail message *for each of a plurality of postal mailing lists, to each of a subset of list members*.

Again, regarding assertion (iv) (quoted in Section 1.3.1), Examiner has merely stated that the prior art discloses that a business may create a list of leads which includes both an e-mail address and a postal address for some leads, and that an email may be sent to a lead asking the lead to confirm the postal mailing address of the lead. This is false.

First, Interactive Marketing News does not disclose sending an e-mail message to a potential lead that requests that the potential lead verify a postal mailing address.

Second, regardless of whether Interactive Marketing News discloses or suggests what is asserted, the assertion is not relevant to the limitations of claim 1. Interactive Marketing News does not disclose selecting a postal mailing list from a plurality of postal mailing lists, based on responses to an e-mail or otherwise and Examiner does not assert that Interactive Marketing

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News either suggests this or can be modified to suggest this feature. The most that can be derived from assertion (iv) is that both an e-mail address and a postal mailing address may be obtained for a member of a mailing list, and that the business utilizing the mailing list may subsequently either e-mail information to the list member using the e-mail address or send information via postal mail. However, there is no disclosure or suggestion in the reference, nor an assertion made by Examiner, that this information can be used to *select for use a postal mailing list from a plurality of postal mailing lists by sending, for each of the plurality of postal mailing lists, an e-mail message to each of a subset of list members, and selecting the postal mailing list based on the responses received.*

1.3.3. No showing of a proper motivation to combine the references

The Examiner simply has not shown a motivation in the prior art of record to modify or combine the disparate references in the way suggested by the Examiner, or in any other manner that renders the claims obvious.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579 (Fed. Cir. 1997).

When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be *Group I*

applied rigorously. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1352 (Fed. Cir. 2001). In each case the factual inquiry whether to combine references must be thorough and searching. Id., at 1352 - 53.

The Examiner has provided one motivation to combine the Druckenmiller and Interactive Marketing News references.

It is asserted that “[i]t would have been obvious to one of ordinary skill at the time of the invention to combine the invention of Druckenmiller with [Interactive Marketing News] because using e-mail to verify postal addresses and to further target recipients provides good leads and increases potential profitability”. Third Office Action, page 6, end of first full paragraph; Fourth Office Action, page 5, end of first paragraph.

This motivation fails for three reasons:

- (a) the motivation is not found in the prior art;
- (b) the motivation would not actually have prompted one to make the proposed combination; and
- (c) the combination does not have anything to do with the embodiment of claim 1, as discussed above in Sections 1.3.1 and 1.3.2.

With respect to reason (a), the motivation is clearly not intimated by any of the references and thus there is no substantial evidence to support it. On the contrary, this motivation is little more than a conclusory statement that the combination would be effective.

With respect to reason (b), the motivation of “using e-mail to verify postal addresses and to further target recipients”, would not cause one to seek out the method of Druckenmiller. Druckenmiller is not concerned with postal mailings, much less how to verify postal addresses. Druckenmiller is instead concerned with building an e-mail mailing list that includes only members that have twice indicated a willingness to be included on the e-mail mailing list.

With respect to reason (c), the combination of Druckenmiller and Interactive Marketing News (as well as any combination of the references) has nothing to do with the embodiment of claim 1. Further, as described above, any such combination would still lack several features of

claim 1, and these features have significant advantages, also as explained above. Finally, any such combination would not solve any the problems addressed by the embodiment of claim 1. The Examiner has provided one motivation to combine the Druckenmiller and Interactive Marketing News references.

The Examiner has provided one motivation for combining the Druckenmiller and Interactive Marketing News references with Applicant's Admissions. The Examiner asserted that it would be obvious to combine Druckenmiller and Interactive Marketing News with Applicant's Admissions because, as Appellants stated in the specification at pages 1 – 3, “[i]t is believed that the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign”. Fourth Office Action, middle of page 5. This motivation fails for two reasons:

(a) the motivation would not actually have prompted one to make the proposed combination; and

(b) the combination does not have anything to do with the embodiment of claim 1, as discussed above in Sections 1.3.1 and 1.3.2.

With respect to reason (a), the motivation that “the choice of mailing list is one of the most critical factors related to the success of a direct marketing campaign”, would not cause one to combine Druckenmiller with Interactive Marketing News. Neither Druckenmiller or Interactive Marketing News is concerned with selecting a postal mailing list from a plurality of postal mailing lists. In fact, Druckenmiller does not address postal mailing lists at all but is instead directed exclusively to e-mail mailing lists. Interactive Marketing News is directed towards generating leads from visitors to Web sites and fails to address selecting a mailing list from a plurality of mailing lists. Accordingly, one of ordinary skill in the art would not have been prompted to combine either Druckenmiller or Interactive Marketing News with Applicant's Admissions based on the motivation that it is important to select the best mailing list for a particular purpose.

With respect to reason (b), the combination of Applicant's Admissions, Druckenmiller and Interactive Marketing News (as well as any combination of the references) has nothing to do with the embodiment of claim 1. Further, as described above, any such combination would still lack several features of claim 1, and these features have significant advantages, also as explained

above. Since Applicant's Admissions merely assert selection of a mailing list is an important factor in a direct marketing campaign, even if combined with the teachings of Druckenmiller and Interactive Marketing News, would not result in the claimed feature of selecting for use a postal mailing list from a plurality of postal mailing lists based on responses to an e-mail message that had been sent, for each of the plurality of postal mailing lists, to a subset of list members. This is due to the simple fact that none of the three references in the combination proposed by the Examiner teach or suggest such a feature. Finally, any such combination would not solve any the problems addressed by the embodiment of claim 1.

In Summary, the Examiner has provided one motivation to combine the Druckenmiller, Applicant's Admissions, and Interactive Marketing News references.

Thus the Examiner has not shown a motivation in the prior art of record to modify or combine the references in any manner that renders the claims of the Group obvious.

Further, it would not be obvious to combine the previously distinct genres of postal mailing lists and e-mail mailing lists. The two fields are considered distinct in the art of direct marketing. This fact is evident, for example, from the article "Taking Stock", Primedia Business Magazines & Media Inc., April 1999 (submitted herewith), in which the e-mail mailing list industry and the postal mailing industry are referred to as two different industries. Page 3, second full paragraph. This fact is further evidenced by the Affidavit of Jay S. Walker, submitted herewith. The fact that prominent businesses that sell or rent mailing lists, such as Acxiom/Direct Media Inc., offer separate and distinct e-mail mailing list (Acxiom Preferred Mail or APM) and postal mailing list services (Acxiom Composer), with no suggestion to correlate the two services, further shows that the two fields are distinct and uncorrelated in the art of direct marketing. Business Wire, October 6, 1997, Acxiom Preferred Mail Generates Dramatic Increase in Direct Marketing Response Rates, and Acxiom Composer Postal Products, printed January 30, 1998, both references of record. Both of these documents were submitted in an I.D.S. filed with the present application on March 11, 1999.

1.3.4. Nonanalogous References

In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

Druckenmiller is directed to the creation of an e-mail mailing list, presupposing that any e-mail mailing list so created will have a high response rate and therefore not concerned with, *e.g.*, any need for how to select an e-mail mailing list. Column 1, line 65 through column 2, line 35.

Interactive Marketing News is directed to methods of generating customer leads for online businesses by collecting information from visitors to a website. Page 1, second and third full paragraphs.

None of the above references is in the field of the Appellant's endeavor, and none of the above references is reasonably pertinent to the particular problem addressed by the embodiment of the claims of the Group, or of any other claim.

1.4. The Claims of Group I are Allowable Over the Cited References

As described above, the Examiner has failed to provide a prima facie showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

1.4.1. The references do not suggest *selecting for use a postal mailing list from a plurality of postal mailing lists, based on responses received to an e-mail message that was sent, for each of the plurality of postal mailing lists, to each of a subset of list members.*

Despite the assertions of the Examiner, Druckenmiller does not disclose or suggest *selecting for use a postal mailing list of a plurality of postal mailing lists*. Simply put, in Druckenmiller there is no description of

selecting for use any mailing list of a plurality of mailing lists, much less of selecting for use a postal mailing list of a plurality of postal mailing lists, much less of selecting for use a postal mailing list of a plurality of postal mailing lists based on responses to an e-mail message, much less of selecting for use a postal mailing list of a plurality of postal mailing lists based on responses to an e-mail message that was sent, for each of the plurality of postal mailing lists, to each of a subset of list members.

Druckenmiller generally describes a method for creating an e-mail mailing list that includes only members who have twice indicated a desire to be included on the e-mail mailing list.

Regarding use of e-mail messages, Druckenmiller describes merely that an e-mail message may be sent (i) to a particular potential e-mail mailing list member to confirm that the member desires to be included on a particular e-mail mailing list, and (ii) to all of the members of a particular e-mail mailing list who have twice indicated a desire to be included on the e-mail mailing list. Abstract.

Interactive Marketing News likewise does not disclose or suggest doing anything with a plurality of postal mailing lists, much less sending an e-mail message to a subset of members of *Group I*

each list, much less the particular limitations of claim 1. At best, Interactive Marketing News describes that both a postal mailing address and an e-mail mailing address may be collected from a potential lead via an online merchant's website. Middle of page 1, paragraph entitled "contests".

Applicant's Admissions likewise do not disclose or suggest selecting a postal mailing list based on responses to an e-mail message, much less doing so based on an e-mail message that had been sent, for each of a plurality of postal mailing lists, to a subset of list members. Applicant's Admissions merely acknowledge that selection of a mailing list is an important step in a direct marketing campaign and go on to discuss why the prior art does not provide an adequate method of doing so.

None of the references, alone or in combination, teach or suggest using e-mail messages in any way to aid in the selection of a plurality of postal mailing lists. At most, Interactive Marketing News discloses that both an e-mail address and a postal mailing address may be requested from persons, with no guarantee that both will be provided.

1.4.2. The references do not suggest *sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members.*

Simply put, whatever e-mail message may be sent in either Druckenmiller or Interactive Marketing News (or any other reference of record), there is no description of it being *sent, for each of a plurality of mailing lists* (much less for each of a plurality of postal mailing lists) *to each of a subset of list members*. Similarly, nothing in Applicant's Admissions suggests this feature of claim 1. Nothing in the references even teaches or suggests sending an e-mail message to a single member of a postal mailing list or to all of the members of a postal mailing list. The references do not suggest combining in any way the previously separate genres of postal mailing lists and e-mail mailing lists for any purposes, much less for the purpose of pre-testing the effectiveness of a plurality of postal mailing lists.

Therefore, nothing in any reference, alone or in combination, can suggest *sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members.*

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In conclusion, the Examiner has not set forth a prima facie case of obviousness of the claims of Group I, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group I, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 1.2 "Advantages of Independent Claim 1". Accordingly, for at least those reasons, the claims of Group I are patentable in view of the cited references.

2. Group II

SEPARATE ARGUMENT OF PATENTABILITY

Group II includes dependent claims **11, 21, 24, 34, 38, and 50**. Dependent claim **11** depends from independent claim **1**, dependent claims **21, 24, 34, and 38** are dependent from independent claim **27**, dependent claim **50** is dependent from independent claim **39**. Independent claims **1, 27, and 39** were discussed above in Group I.

Accordingly, all arguments above with respect to Group I are equally applicable to Group II, and the claims of Group II are patentable at least for the same reasons given above for Group I. Moreover, additional arguments are provided below for the patentability of the claims of Group II, regardless of the patentability of the claims of Group I.

For brevity, the discussion below refers to claim **11**, but the arguments are likewise applicable to claims **21, 24, 34, 38, and 50**.

2.1. Dependent Claim 11

Dependent claim **11** is directed to a method for providing a mailing list test service involving a plurality of postal mailing lists. The method comprises *determining a response rate of each of the plurality of postal mailing lists and selecting the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists*.

The response rate for each of the plurality of postal mailing lists is determined from the responses received to an e-mail message. The e-mail message is a message that was sent, for each postal mailing list in the plurality of postal mailing lists, to each of a subset of list members.

2.2. Advantages of Dependent Claim 11

The embodiment of claim 11 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination.

In addition to the advantages discussed above with respect to Group I, by *selecting for use the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists, [the response rates being rates of response to an e-mail message that had been sent, for each postal mailing list in a plurality of postal mailing lists, to each of a subset of list members]*, the business that is going to use the selected postal mailing list can be reassured that the expected response rate to the planned postal mailing for which the postal mailing list is being selected will likely be higher than the response rate would have been for the other postal mailing lists that were not selected. This is because Appellants have recognized that e-mail mailing lists which correspond to postal mailing lists may be used to “pre-test” the effectiveness of the postal mailing lists. Appellants’ have also recognized that an e-mail mailing list may serve as a reliable response predictor of its associated postal mailing list. Present Application, page 4, lines 22 through 25. In other words, if a subset of members of a first postal mailing list responded in greater numbers to an e-mail message than a subset of members of a second postal mailing list, Appellants have recognized that this information can be used to predict that the entirety of members of the first mailing list will also respond in higher numbers to a planned postal mailing related to the e-mail message than would the entirety of members of the second postal mailing list.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants’ disclosure.

2.3. No Prima Facie Showing of Unpatentability of the Claims of Group II

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not *Group II*

disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

In general, the references fail to suggest selecting a postal mailing list that has a higher response rate than other postal mailing lists, where the response rate is determined based on responses to an e-mail message.

2.3.1. No showing that the references suggest selecting for use the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists, [the response rates being rates of response to an e-mail message that had been sent, for each postal mailing list in a plurality of postal mailing lists, to each of a subset of list members]

In support of the rejection of this claim, Examiner asserted that Druckenmiller “[i]ndicate[s] the importance of a maximized response rate (column 8, lines 19 – 32).” Third Office Action, page 7, beginning of last paragraph. This assertion does not address the limitation of claim 11, namely that a response rate for a plurality of postal mailing lists is determined (*i.e.*, based on responses to an e-mail message that was sent, for each postal mailing list in a plurality of postal mailing lists, to each of a subset of list members).

The mere assertion that a result of a claimed method is recognized in the prior art as a desirable result does not meet the Examiner’s burden of showing that the claimed method of reaching the result is known or obvious. Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Further, the passage of Druckenmiller cited by Examiner addresses the desirability of the e-mail mailing list created by the Druckenmiller system, in that the created e-mail mailing list has “a significantly improved degree of confidence in the desire of the listed subscribers to received directed messages about particular topics.” The passage of Druckenmiller is devoid of any suggestion of a response rate for a postal mailing list, much less response rates for a plurality of mailing lists, much less the limitation of claim 11 of selecting a mailing list with a higher response rate than other mailing lists, where the response rate is determined based on responses to an e-mail message.

Group II

Official Notice

In addition, Examiner has asserted (in what appears to be the taking of Official Notice) that “[i]nherently, selection of mailing lists that provide positive proof of increased and voluntary participation by the members on the mailing list are more valuable than lists which have old, untested, or unresponsive members.” Third Office Action, page 7, middle of last paragraph. First, Appellants note that Appellants have previously requested documentation supporting the subject matter of this Official Notice, which request was not responded to by Examiner and which documentation has not been provided. Response to the Third Office Action mailed June 05, 2002, page 10, paragraph 3. No evidence in the record supports the Examiner’s assertions.

Second, this assertion is again a mere conclusory statement that a result allowed by the claimed method is a desirable result, and does not at all address whether the prior art of record suggests the claimed limitation of selecting a postal mailing list that has a highest response rate.

In addition, Examiner has asserted that “mailing lists with low response rates are considered less than ideal (column 1, lines 14 – 23), versus mailing lists with greater response rates, which are inherently more valuable to the organization attempting to profit from the list (column 1, lines 40 – 41). Also, it is inherent to the development of evaluating the usefulness of a mailing list by its response rate to calculate and determine a quantitative or qualitative grade of the rate of member response. Furthermore, when selecting a mailing list for deployment, response rate is an inherent factor.” Third Office Action, bottom of page 7 through top of page 8. Again, these conclusory statements fail to address any of the particular limitations of claim 11, instead merely asserting that the result that may be achieved by use of claim 11 is a desirable result.

2.3.2. No showing of a proper motivation to combine the references

The Examiner simply has not shown a motivation in the prior art of record to modify or combine the disparate references in the way suggested by the Examiner, or in any other manner that renders the claims obvious.

Group II

In addition to the deficiencies described in Section 1.3.3 above, the Examiner has utterly failed to assert any reason for why one of ordinary skill in the art would have been motivated to combine Druckenmiller with the facts that Official Notice was taken of or to modify Druckenmiller such that it did disclose the claim limitations. Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

2.4. The Claims of Group II are Allowable Over the Cited References

As described above, the Examiner has failed to provide a prima facie showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

2.4.1. The references do not suggest *selecting for use the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists, [the response rates being rates of response to an e-mail message that had been sent, for each postal mailing list in a plurality of postal mailing lists, to each of a subset of list members]*

As discussed in Section 1.4.1, Druckenmiller does not even hint at selecting a mailing list (whether it be a postal mailing list or an e-mail mailing list) from a plurality of mailing lists based on any factor. Druckenmiller similarly does not suggest selecting a postal mailing list that has a response rate higher than the response rates of other postal mailing list, much less at making the selection based on a response rate that was determined from responses to an e-mail message that was sent, for each of the plurality of postal mailing lists, to a subset of list members.

In conclusion, the Examiner has not set forth a prima facie case of obviousness of the claims of Group II, none of the references (alone or in combination) disclose or suggest the *Group II*

limitations of the claims of Group II, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 2.2 "Advantages of Dependent Claim 11". Accordingly, for at least those reasons, the claims of Group II are patentable in view of the cited references.

3. Group III

SEPARATE ARGUMENT OF PATENTABILITY

Group III includes dependent claims **4, 17, 30, and 42**. Dependent claim **4** depends from independent claim **1**, dependent claim **17** depends from independent claim **14**, dependent claim **30** depends from independent claim **27**, and dependent claim **42** depends from independent claim **39**. Independent claims **1, 14, 27, and 39** were discussed above in Group I. Accordingly, all arguments above with respect to Group I are equally applicable to Group III, and the claims of Group III are patentable at least for the same reasons given above for Group I. Moreover, additional arguments are provided below for the patentability of the claims of Group III, regardless of the patentability of the claims of Group I.

For brevity, the discussion below refers to claim **4**, but the arguments are likewise applicable to claims **17, 30, and 42**.

3.1. Dependent Claim 4

Dependent claim **4** is directed to a method for providing a mailing list test service involving a plurality of postal mailing lists. The method comprises *mailing information via post to list members of the postal mailing list*. The postal mailing list to which the information is mailed is first selected based on responses to an e-mail message that had been sent, for each of the plurality of postal mailing lists, to each of a subset of list members.

3.2. Advantages of Dependent Claim 4

In general, the limitation of claim **4** is advantageous in that it allows advertising and other information to be mailed via postal mail once a postal mailing list has been selected based on responses to an e-mail message.

Group III

The embodiments of claim 4 provide several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination.

In addition to the advantages discussed above with respect to Group I, by *mailing information via post to list members of the postal mailing list*, a business utilizing a postal mailing list (selected in accordance with, *e.g.*, the method of claim 1) realizes the substantial benefits of utilizing postal direct marketing materials.

As described in the present application, it is believed that the choice of a mailing list is one of the most critical factors related to the success of a direct marketing campaign. This is because the best list can often result in ten times the response as the worst list for an identical mailing piece. Present Application, page 2, lines 4 – 10. Additionally, internet based mailing lists which include e-mail addresses for direct marketing were becoming increasingly popular at the time of the invention. However, although e-mail campaigns can be set up and executed in a relatively short amount of time and can begin to generate responses almost immediately, the impact of a direct marketing e-mail mailing is not nearly as high as that of, *e.g.*, a postal mailing. This is because the postal mailing is a more tangible good in the prospective consumer's hand. Also, a person is more likely to flip through a longer brochure at home than to click through one at their PC terminal. Thus, postal mailing remains the most effective process for attracting the buying power of a consumer. Present Application, page 2, lines 20 – 31. Appellants have recognized that the advantages of e-mail direct marketing (speed, efficiency, cost-effectiveness) can be utilized to test postal mailing lists and find the ideal postal mailing list, while the benefits of utilizing postal mailings for the actual direct marketing campaign may be retained once the ideal postal mailing list is selected.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

3.3. No Prima Facie Showing of Unpatentability of the Claims of Group III

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not *Group III*

disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

In general, the references fail to suggest mailing information by post to members of a postal mailing list that had been selected based on responses to an e-mail message.

3.3.1. No showing that the references suggest *mailing information via post to list members of the postal mailing list that had previously been selected based on responses to an e-mail message that had been sent, for each of the plurality of postal mailing lists including the selected postal mailing list, to each of a subset of list members.*

Regarding claim 4, Examiner states that although “Druckenmiller does not disclose renting the mailing lists[,] Applicant..., on page 1, line 29 to page 2, line 1 of the specification, discloses that a mailing list may be used to ‘mail promotional items such as brochures, advertisements, or sales offers to person included in the list.’” Third Office Action, page 10, beginning of second paragraph. First, with this assertion Examiner has failed to show what in the prior art renders obvious the actual claim limitations: *mailing information via post to members of a postal mailing list that was previously selected based on responses to an e-mail message that had been sent, for each of a plurality of postal mailing lists including the selected postal mailing list, to each of a subset of list members.* Second, Examiner’s statement that “Druckenmiller does not disclose renting the mailing lists” is not relevant to the limitations recited in claim 4. Accordingly, the only remaining relevant assertion that Examiner made in support of the rejection of claim 4 (that mailing items to members of a mailing list is known) in no way shows that the prior art teaches or suggests the whole of claim 4 – mailing information via post to members of a postal mailing list that was previously selected by the method set out in the claim.

3.3.2. No showing of a proper motivation to combine the references

The Examiner simply has not shown a motivation in the prior art of record to modify or combine the disparate references in the way suggested by the Examiner, or in any other manner that renders the claims obvious.

In addition to the deficiencies described in Section 1.3.3 above, the Examiner has asserted with respect to claim 4 that “it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and then mailing items to members on the mailing list because a reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization’s customer/client base, thereby generating potential growth. Directly mailing brochures, advertisements, or sales offers promotes reasonable expansion by selectively targeting individual [sic] and groups who may be interested in involving themselves with the organization.” Third Office Action, page 10, bottom of last paragraph through page 11, top of first paragraph.

This motivation fails for two reasons:

- (a) this motivation would not actually have prompted one to make the proposed combination; and
- (b) the combination has nothing to do with the embodiment of claim 4, as discussed above in Section 3.3.1.

With respect to reason (b), the motivation of “reliable and accurate list of customer leads is a valuable asset, and acquiring such lists provides an opportunity to expand an organization’s customer/client base, thereby generating potential growth. Directly mailing brochures, advertisements, or sales offers promotes reasonable expansion by selectively targeting individual [sic] and groups who may be interested in involving themselves with the organization”, would not have prompted one to select a postal mailing list to send information via post to by first sending e-mail messages, for each of a plurality of postal mailing lists, to each of a subset of list members. As discussed above, Druckenmiller does not disclose or suggest postal mailing lists at all, since Druckenmiller is limited to e-mail mailing lists. As also discussed above, Druckenmiller does not disclose any method or motivation for selecting any mailing list (whether

Group III

it be a postal mailing list or an e-mail mailing list) from a plurality of mailing lists by any method, much less the particular method (of using e-mail to pretest a plurality of postal mailing lists) claimed.

With respect to reason (b), the combination (as well as any combination of the references) has nothing to do with the embodiment of claim 4. The references do not even hint at selecting for use a postal mailing list based on responses to an e-mail message. Further, as described above, any such combination would still lack several features of claim 4, and these features have significant advantages, also as explained above. Further, any such combination would not solve any the problems addressed by the embodiment of claim 4.

Thus the Examiner has not shown a motivation in the prior art of record to modify or combine the references in any manner that renders the claims of the Group obvious.

3.4. The Claims of Group III are Allowable Over the Cited References

As described above, the Examiner has failed to provide a prima facie showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

3.4.1. The references do not suggest *mailing information via post to list members of the postal mailing list, where the postal mailing list to which the information is mailed is first selected based on responses to an e-mail message that had been sent, for each of the plurality of postal mailing lists, to each of a subset of list members.*

None of the references even hint at sending information via post to members of a postal mailing list that was previously selected based on responses to an e-mail message. None of the references disclose any method for selecting a mailing list (whether it be a postal mailing list or an e-mail mailing list) from a plurality of mailing lists, much less of mixing the two previously

Group III

separate genres of e-mail mailing lists and postal mailing lists by using e-mail to test which postal mailing list to send the information via post to.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group III, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group III, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 3.2 "Advantages of Dependent Claim 4". Accordingly, for at least those reasons, the claims of Group III are patentable in view of the cited references.

4. Group IV

SEPARATE ARGUMENT OF PATENTABILITY

Group IV includes dependent claims **13 and 26**. Dependent claim **14** depends from independent claim **1**, and dependent claim **26** depends from independent claim **14**. Independent claims **1 and 14** were discussed above in Group I. Accordingly, all arguments above with respect to Group I are equally applicable to Group IV, and the claims of Group IV are patentable at least for the same reasons given above for Group I. Moreover, additional arguments are provided below for the patentability of the claims of Group IV, regardless of the patentability of the claims of Group I.

For brevity, the discussion below refers to claim **13**, but the arguments are likewise applicable to claim **26**.

4.1. Dependent Claim 13

Dependent claim **13** is directed to a method for providing a mailing list test service involving a plurality of postal mailing lists. The method includes compensating a member of a postal mailing list for a received response to an e-mail message, the e-mail message having been sent, for each postal mailing list of a plurality of postal mailing lists, to each of a subset of list members.

4.2. Advantages of Dependent Claim 13

The embodiments of claim **13** provide several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination.

In addition to the advantages discussed above with respect to Group I, by *compensating a list member for a response received to an e-mail message*, the likelihood that the list member

Group IV

will subsequently also respond to a postal mailing regarding the same or similar subject matter is substantially increased.

As described in the present application, it is believed that if a list member responds to an e-mail message regarding particular subject matter of a planned postal mailing, the list member is also likely to respond to a subsequent postal mailing regarding the same subject matter. This is because it is likely, from the list members response to the e-mail message, that the list member is interested in the subject matter or business or other entity associated with the e-mail message. This likelihood that the list member will in fact respond to a subsequent postal mailing regarding the same or similar subject matter or associated with the same business or entity that was associated with the e-mail message may be increased if the list member is compensated in some manner for responding to the e-mail message. The list member is likely to recall the compensation and associate the subject matter or business or other entity associated with both the e-mail message and the postal mailing with the benefit received as compensation. The resulting positive feelings evoked by the remembered compensation may result in the list member's willingness to respond to the postal mailing.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

4.3. No Prima Facie Showing of Unpatentability of the Claims of Group IV

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

In general, the references fail to suggest compensating, for a response to an e-mail message, a member of a mailing list who is associated with the response.

Group IV

4.3.1. No showing that the references suggest *compensating a list member associated with a response for the response*.

Regarding claim 13, Examiner states that “Druckenmiller discloses the subscription verification method as disclosed in the rejections of claim 1. Druckenmiller does not disclose compensating list members with an incentive. McEvoy, however, in column 5, lines 13 – 27, discloses an incentive as one of many possible services of the marketing research campaign compiling a mailing list.” Third Office Action, page 11, last full paragraph; Fourth Office Action, middle of page 10.

The cited passage of McEvoy, as well as the remainder of McEvoy, does not suggest providing compensation for responding to an e-mail message. Rather, McEvoy discloses providing a coupon to a customer, the coupon being the incentive referred to by Examiner. The customer in McEvoy is not provided the coupon as compensation for doing anything, much less for responding to an e-mail message. Rather, the coupon is provided to the customer as a gift, in the hope that the customer will utilize the coupon. The information included on the label that the customer affixes to the coupon allows tracking of redemption of the coupon. Accordingly, Examiner has not shown that the claimed limitation of *compensating a list member for a response to an e-mail message* is disclosed or suggested in the prior art.

4.3.2. No showing of a proper motivation to combine the references

The Examiner simply has not shown a motivation in the prior art of record to modify or combine the disparate references in the way suggested by the Examiner, or in any other manner that renders the claims obvious.

In addition to the deficiencies described in Section 1.3.3 above, the Examiner has asserted with respect to claim 13 that “it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the practice of creating a mailing list and compensating members who join the list because a reliable and accurate list of customer leads is a valuable asset, and enticing members with an incentive is a proven and effective way to increase

participation, thereby increasing the value of the mailing list.” Third Office Action, page 11, last full paragraph; Fourth Office Action, page 10, last full paragraph.

This motivation fails for four reasons:

- (a) the motivation is not found in the prior art;
- (b) this motivation would not actually have prompted one to make the proposed combination;
- (c) this motivation would not in any way further the proposed combination; and
- (d) the combination has nothing to do with the embodiment of claim 13, as discussed above in Section 4.3.1.

With respect to reason (a), the motivation is clearly not intimated by any of the references, and thus there is no substantial evidence to support it. On the contrary, this motivation is little more than a conclusory statement that the combination would be effective.

With respect to reason (b), the motivation of creating a “reliable and accurate list of customer leads” would not cause one to pay customers for responding to a verification e-mail in Druckenmiller. The stated objective of Druckenmiller is to create an e-mail mailing list whose members definitely and voluntarily desire to receive e-mails about selected topics. Column 1, lines 54 – 59. Not only would it be useless to pay a recipient of a verification e-mail in Druckenmiller to respond to the verification e-mail, the payment for responses would defeat the objective of obtaining voluntary members. A recipient might very well respond to the verification e-mail simply to receive the compensation, not because the recipient truly desires to be placed on the e-mail mailing list in question. Accordingly, the created e-mail mailing list would be tainted by the inclusion of members who may not really wish to receive e-mails but may rather have simply responded to obtain compensation.

Thus, one wishing to create an e-mail mailing list that is accurate and reliable would actually refrain from compensating members in exchange for their agreements to be placed on the list, for fear of tainting the reliability of the resultant e-mail mailing list. Further, neither Druckenmiller nor McEvoy discloses compensating members of an e-mail mailing list for responding to e-mails. For this reason as well, the above motivation would not have prompted one to make the proposed combination.

Group IV

With respect to reason (c), the combination of Druckenmiller and McEvoy does not further the motivation of creating a “reliable and accurate list of customer leads”. The combination of Druckenmiller and McEvoy at most results in including an incentive (*e.g.*, an electronic coupon) in an e-mail message and tracking the redemption of this coupon. Although a recipient of such a coupon may utilize the coupon, this would not necessarily mean that the recipient is confirming a desire to be included on an e-mail mailing list. Rather, the recipient may simply desire to realize the discount offered by the coupon. Accordingly, if an e-mail mailing list were created based on redemption of such a coupon, the proposed motivation would not be realized because the resultant list may again be tainted by inclusion of persons that do not necessarily desire to be included on the list.

With respect to reason (d), the proposed combination of Druckenmiller and McEvoy has nothing to do with the embodiment of claim 13. Neither reference teaches *compensating a list member for responding to an e-mail message*. Further, the stated combination results in a method of creating a mailing list that is proposed to be accurate and reliable. However, claim 13 has nothing to do with creating a mailing list at all, but rather recites a method for selecting among a plurality of postal mailing lists.

Thus the Examiner has not shown a motivation in the prior art of record to modify or combine the references in any manner that renders the claims of the Group obvious.

4.4. Nonanalogous References

In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In Re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

Druckenmiller is directed to the creation of an e-mail mailing list based on verified indications of interest from potential list members. Abstract.

McEvoy is directed to system and method of creating a mailing list based on, *e.g.*, redemption of a coupon by recipients of a mailing label that can be applied to the coupon.

Abstract.
Group IV

Neither of the above references is in the field of the Appelants' endeavor, and neither of the above references is reasonably pertinent to the particular problem addressed by the embodiment of the claims of the Group (selecting a postal mailing list from a plurality of postal mailing lists), or of any other claim.

4.5. The Claims of Group IV are Allowable Over the Cited References

As described above, the Examiner has failed to provide a *prima facie* showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

4.5.1. The references do not suggest *compensating a list member associated with a response for the response.*

None of the references even hint at compensating a member of a postal mailing list for any particular action, much less for responding to an e-mail message.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group IV, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group IV, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 4.2 "Advantages of Dependent Claim 13". Accordingly, for at least those reasons, the claims of Group IV are patentable in view of the cited references.

5. Group V

SEPARATE ARGUMENT OF PATENTABILITY

Group V includes dependent claims **8, 22, 23, 35, and 47**. Dependent claim **8** depends from independent claim **1**, dependent claims **22 and 23** depends from independent claim **14**, dependent claim **35** depends from independent claim **27**, and dependent claim **47** depends from independent claim **39**. Each of independent claims **1, 14, 27, and 39** are discussed above in Group I. Accordingly, all arguments above with respect to Group I are equally applicable to Group V, and the claims of Group V are patentable at least for the same reasons given above for Group I. Moreover, additional arguments are provided below for the patentability of the claims of Group V, regardless of the patentability of the claims of Group I.

As discussed below, the rejection of the claims of Group V is flawed because the Examiner has not made a prima facie case of unpatentability of any claim of Group V. The Examiner has not shown all limitations of any claim to be disclosed or suggested by the references. The rejection is also based on improper combinations and modifications of the references without adequate motivation in the prior art for making the proposed combinations and modifications.

Further, no claim of Group V can be deemed obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group V obvious.

5.1. Dependent Claim 8

Dependent claim **8** is directed to a method for providing a mailing list test service involving a plurality of postal mailing lists. The method comprises *receiving a response to an e-mail message that was sent, for each of a plurality of postal mailing lists, to a subset of list*

Group V

members, the response including a test identifier and a member identifier, and retrieving a test record from a test database based on the received test identifier. The test record is then updated to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.

For brevity, the discussion below refers to method claim 8, but the arguments are likewise applicable to claims 22, 23, 35, and 47.

5.2. Advantages of Dependent Claim 8

In addition to the advantages discussed above in Section 1.2 with respect to Group I, the embodiment of claim 8 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

Because *a received response includes a test identifier and a member identifier*, and the *test identifier is used to retrieve a test record from a test database*, a test of a plurality of postal mailing lists may be tracked to compare the responses received for each of the individual postal mailing lists included in the postal mailing list. This facilitates the selection of a postal mailing list from a plurality of postal mailing lists based on responses received to an e-mail message that had been sent, for each of the plurality of postal mailing lists, to a subset of list members.

Because the *member identifier [that was included in the response] is used to update the test record to disclose that a response was received from a member*, numerous advantages may be realized from updating a test record in a test database to disclose that a response was received from a member of a postal mailing list that is included in a test. For example, the response rate for each postal mailing list included in the test being tracked by the test record may subsequently be easily calculated. Furthermore, the number of responses associated with each postal mailing list included in the test may be compared easily and the response rate for the sum of the postal mailing lists (to determine the response rate for the e-mail message in general) may easily be determined from the updated test record. Application, page 23, lines 17 - 29. Accordingly, many

businesses that are using the testing service of claim 8 will benefit from access to valuable test result data.

A comparison of response rates associated with respective postal mailing lists included in a test may be used by a business, for example, to select the postal mailing list for purchase that has the highest associated response rate.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

5.3. No Prima Facie Showing of Unpatentability of the Claims of Group V

A reading of the rejections of the claims of the Group reveals that the Examiner has consistently ignored or misinterpreted the limitations of the claims. Several limitations are not disclosed or suggested by the references of record. Accordingly, the Examiner has not presented a prima facie case of obviousness of any claim of the Group.

In general, the references (alone or in combination) do not suggest a test record in a test database. Accordingly, the references do not suggest receiving a response that includes a test identifier, nor updating the test record as recited in claim 8.

5.3.1. No showing that the references suggest retrieving a test record from a test database based on the received test identifier which test record is in turn updated to disclose, based on the received member identifier, that a response [to an e-mail sent to a member of a postal mailing list] was received from a member associated with the member identifier

As is clear from the Present Application, a test record of a test database includes information about at least a plurality of postal mailing lists and / or information about a plurality of members of the various postal mailing lists being tested , if not also information about the business for which the test is being performed (e.g., the business that is interested in purchasing or renting one of the postal mailing lists included in the test). Present Application, Figures 6A
Group V

and 6B. In Druckenmiller, the token is associated only with a single e-mail address and thus the single recipient that corresponds to the e-mail address. Accordingly, any record in any database that is retrieved based on the token identifier in Druckenmiller cannot comprise a test record of a test database, since the record of Druckenmiller does not include information about a plurality of members or a plurality of mailing lists (whether postal mailing lists or e-mail mailing lists). No attempt has been made on Examiner's part as to how or why Druckenmiller may be modified such that it does teach a record of a database that includes a token identifier may be modified such that it identifies a *test record* of a *test database* as is claimed.

5.3.2. No Showing of a motivation to modify the reference

The Examiner has not shown any motivation to modify Druckenmiller in any way that renders the claim obvious. In fact, Examiner has not addressed at all the need to modify Druckenmiller in order for the claimed limitations to be rendered obvious. Instead, the Examiner has merely asserted that the token of Druckenmiller is a test identifier, without addressing at all the fact that Druckenmiller does not disclose or suggest any sort of "test" of a plurality of mailing lists (whether they be e-mail mailing lists or postal mailing lists) that would need to be identified. Further, Examiner has not addressed the differences between a test identifier, test record, and test database, as the terms are used in the Present Application, and the token identifier in Druckenmiller, much less why or how one of ordinary skill in the art would have been motivated to modify the token identifier of Druckenmiller such that it rendered the claimed limitations obvious.

5.4. The Claims of Group V are Allowable Over the Cited References

As described above, the Examiner has failed to provide a prima facie showing of obviousness. In addition, the references cannot be combined in any manner that would render the claims of the Group obvious.

Group V

5.4.1. The references do not suggest a received response that includes a test identifier and a member identifier, where the test identifier is used to retrieve a test record from a test database and the member identifier is used to update the test record to disclose that a response was received from a member associated with the member identifier.

No reference discloses *test*, much less a *test identifier* or a *test record* of a *test database* that is retrieved based on the *test identifier* and updated.

Druckenmiller does not mention a test of a plurality of mailing lists (whether they be postal mailing lists or e-mail mailing lists). In fact, one of ordinary skill in the art would not be motivated to modify Druckenmiller such that is included a test of a plurality of postal mailing lists, or even a plurality of e-mail mailing lists, since Druckenmiller presupposes that any e-mail mailing list created with the Druckenmiller method is a reliable list that is expected to have a high response rate or result in favorable responses, since each member of the list has twice indicated a desire to be included on the particular e-mail mailing list. Column 2, lines 32 – 34.

Druckenmiller merely describes verifying that an individual in fact does desire to be included on an e-mail mailing list. This verification is performed by sending a verification e-mail to the individual, the verification e-mail including a unique token. A verification is not a test. A verification comprises reaffirmation of information that is already known. A test, as the term is used in the Present Application, seeks to determine new information that was previously unknown (*e.g.*, an expected response rate for a postal mailing list as compared to an expected response rate for a second postal mailing list). Further, the term *test* in the Present Application is clearly used to mean a test of a plurality of postal mailing lists. Druckenmiller does not disclose a test of a plurality of e-mail mailing lists, much less a plurality of postal mailing lists.

In conclusion, the Examiner has not set forth a *prima facie* case of obviousness of the claims of Group V, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group V, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 5.2 "Advantages of Dependent Claim 8". Accordingly, for at least those reasons, the claims of Group V are patentable in view of the cited references.

Group V

6. Group VI

SEPARATE ARGUMENT OF PATENTABILITY

Group VI includes dependent claims **5 – 7, 18 – 20, 31 – 34, 43, 45 and 46**. Dependent claims **5 – 7** depend from independent claim **1**, dependent claims **18 – 20** depend from independent claim **1**, dependent claims **31 – 34** depend from independent claim **27**, and dependent claims **43, 45 and 46** depend from independent claim **39**. Each of independent claims **1, 14, 27, and 39** are discussed above in Group I. Accordingly, all arguments above with respect to Group I are equally applicable to Group VI, and the claims of Group VI are patentable at least for the same reasons given above for Group I. Moreover, additional arguments are provided below for the patentability of the claims of Group VI, regardless of the patentability of the claims of Group I.

The Examiner has indicated that claims **5 – 7, 18 – 20, 31 – 34, 43, 45 and 46** “would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Fourth Office Action, bottom of page 2.

Appellants agree with the Examiner that the claims of Group VI are patentable over the prior art. No claim of Group VI can be deemed anticipated by or obvious in light of the references of record, alone or in any combination, because the cited references, alone or in any combination, cannot be interpreted in a manner that would disclose or suggest the limitations of any pending claim. Further, the prior art of record does not contain any proper motivation to combine or modify the references in any way which renders any claim of Group VI obvious.

6.1. Dependent Claim 5

Dependent claim **5** is directed to a method for providing a mailing list test service involving a plurality of postal mailing lists. The method comprises *sending a first e-mail message to a first member of a postal mailing list and sending a second e-mail message to a second member of the postal mailing list, wherein the first e-mail message includes content different from the second e-mail message.*

Group VI

For brevity, the discussion below refers to dependent claim 5, but the arguments are likewise applicable to claims 6 – 7, 18 – 20, 31 – 34, 43, 45 and 46.

6.2. Advantages of Dependent Claim 5

In addition to the advantages discussed above in Section 1.2 with respect to Group I, the embodiment of claim 5 provides several advantages not even recognized, much less disclosed or suggested, by the prior art of record, either alone or in combination. These advantages further render the claimed subject matter nonobvious over the cited art.

Because *a first e-mail message includes content different from the second e-mail message*, the method allows testing of not only the responsiveness of members of a postal mailing list, but also testing of various possible versions or content to be sent via a postal mailing.

A great many more advantageous and diverse uses of the claimed invention, both explicit and implicit in the present Application, are possible and would be apparent to those of skill in the art based on the Appellants' disclosure.

6.3. The Claims of Group VI are Allowable Over the Cited References

As described above, the references cannot be combined in any manner that would render the claims of the Group anticipated by or obvious.

6.3.1. The references do not suggest *sending a first e-mail message to a first member of a postal mailing list and sending a second e-mail message to a second member of the postal mailing list, wherein the first e-mail message includes content different from the second e-mail message.*

Group VI

No reference discloses sending an e-mail message to a member of a postal mailing list, much less sending e-mail message including different content to different members of the postal mailing list.

Druckenmiller does not mention sending e-mails to members of a postal mailing list. Druckenmiller is limited to teaching sending e-mail messages to members of an e-mail mailing list. However, the content of an e-mail message sent to all members of an e-mail mailing list in Druckenmiller is the same. In other words, all members of an e-mail mailing list in Druckenmiller receive an e-mail message of the same content.

Similarly, Interactive Marketing News also does not teach sending e-mail messages including different content to different members of an e-mail mailing list, much less to members of a postal mailing list. Interactive Marketing News, like Druckenmiller, merely teaches sending an e-mail message having the same content to all members of an e-mail mailing list.

Further, nowhere in Applicant's Admissions is it asserted that it was known, prior to Appellants' invention, to *send an e-mail message to a first member of a postal mailing list and a second e-mail message to a second member of the postal mailing list, wherein the first e-mail message includes content different from the second e-mail message.*

In conclusion, none of the references (alone or in combination) disclose or suggest the limitations of the claims of Group VI, and none of the references (alone or in combination) possess the advantages conferred by those limitations, as discussed in detail above in Section 6.2 "Advantages of Dependent Claim 5". Accordingly, for at least those reasons, the claims of Group VI are patentable in view of the cited references.

CONCLUSION

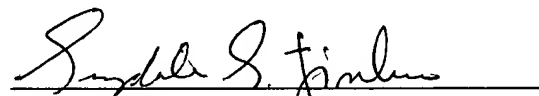
Thus, the Examiner's rejection of the pending claims are is improper at least because the all pending claims are directed to statutory subject matter. In addition, the references, alone or in combination, do not disclose or suggest all the limitations of any claim. In addition, in the obviousness rejections the Examiner has improperly combined the references because there is no adequate reasoning or support in the prior art for making the proposed combination. Therefore, Appellants respectfully request that the Examiner's rejections be reversed.

If any issues remain, or if there are any further suggestions for expediting allowance of the present application, please contact Magdalena M. Fincham using the information provided below.

Appellants hereby request any extension of time that may be required to make this Appeal Brief timely. Please charge any fees that may be required for this paper, or credit any overpayment, to Deposit Account No. 50-0271.

Respectfully submitted,

February 27, 2004
Date



Magdalena M. Fincham
Attorney for Appellants
Registration No. 46,085
Walker Digital Management, LLC
mfincham@walkerdigital.com
(203) 461 - 7041 /voice
(203) 461-7300 /fax

APPENDIX A
CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL

Claims 1 – 50 are pending and appealed.

Claims 1, 14, 27, and 39 are independent.

1. A method for providing a mailing list test service involving a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member, the method comprising:

(a) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;

(b) receiving a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from one of the subsets of list members; and

(c) selecting for use, based on the responses received in (b), one of the plurality of postal mailing lists.

2. The method of claim 1, further comprising:

(d) selling the postal mailing list selected in (c).

3. The method of claim 1, further comprising:

(d) renting to another the postal mailing list selected in (c).

4. The method of claim 1, further comprising:

(d) mailing information via post to list members of the postal mailing list selected in (c).

CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL

5. The method of claim 1, wherein said sending an e-mail message in (a) includes:
 - (i) sending, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and
 - (ii) sending, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset;wherein the first e-mail message includes content different from the second e-mail message.
6. The method of claim 5, further comprising:
 - (d) storing the responses received in (b).
7. The method of claim 5, wherein at least one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of content, and wherein the selecting in (c) includes selecting at least one of the plurality of postal mailing lists based on mailing list content included in the e-mail messages sent in (a).
8. The method of claim 1, wherein each response received in (b) includes a test identifier and a member identifier, and comprising the further steps of:
 - (d) retrieving a test record from a test database based on the received test identifier; and
 - (e) updating the retrieved test record to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.
9. The method of claim 8, wherein each response received in (b) further includes a question identifier and an answer identifier.
10. The method of claim 9, wherein said selecting one of the plurality of postal mailing lists includes selecting based on the received question identifier and the received answer identifier.

11. The method of claim 1, wherein said selecting one of the plurality of postal mailing lists includes:

- (i) determining a response rate of each of the plurality of postal mailing lists; and
- (ii) selecting the postal mailing list that has a response rate higher than the response rates of the other postal mailing lists.

12. The method of claim 1, wherein said receiving responses includes detecting the use of a uniform resource locator embedded in the e-mail message.

13. The method of claim 1, wherein a list member associated with a received response is compensated for the response.

14. An apparatus for providing a mailing list test service, comprising:

- (a) a processor;
- (b) a database including a plurality of postal mailing lists, each postal mailing list having information about a plurality of list members, the information including a postal address for each list member;
- (c) a port coupled to said processor; and
- (d) a memory including a database, said memory coupled to said processor, and said memory storing instructions adapted to be executed by said processor, the instructions including:
 - (i) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;
 - (ii) receiving a plurality of responses, each received response corresponding to an e-mail message sent in (i), each received response being associated with a list member from one of the subsets of list members; and
 - (iii) selecting for use, based on the responses received in (ii), one of the plurality of postal mailing lists.

15. The apparatus of claim 14, wherein said memory stores further instructions adapted to be executed by said processor, said further instructions including:

- (iv) selling the postal mailing list selected in (iii).

CLEAN COPY OF CLAIMS INVOLVED IN THE APPEAL

16. The apparatus of claim 14, wherein said memory stores further instructions adapted to be executed by said processor, said further instructions including:

(iv) renting to another the postal mailing list selected in (iii).

17. The apparatus of claim 14, wherein said memory stores further instructions adapted to be executed by said processor, said further instructions including:

(iv) mailing information via post to members of the postal mailing list selected in (iii).

18. The apparatus of claim 14, wherein the instructions to send an e-mail message include instructions adapted to be executed by a processor to:

send, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and

send, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset, wherein the first e-mail message includes content different from the second e-mail message.

19. The apparatus of claim 18, said memory storing further instructions adapted to be executed by said processor, the instructions including:

(iv) storing the responses received in (ii).

20. The apparatus of claim 18, wherein one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of mailing list content, and wherein selecting in (iii) includes selecting one of the plurality of postal mailing lists based on mailing list content included in the e-mail messages sent in (i).

21. The apparatus of claim 20, wherein selecting in (iii) further includes:
- (i) determining a response rate of each of the plurality of postal mailing lists; and
 - (ii) selecting a postal mailing list from the plurality of postal mailing lists that has a response rate higher than the response rate of the other postal mailing lists.
22. The apparatus of claim 14, said database including a mailing list database containing a member identifier, a test database containing a test identifier, a questions database, an answer database, and said memory storing further instructions adapted to be executed on said processor, the further instructions including:
- (iv) retrieving a test record from the test database based on a received test identifier; and
 - (v) marking the retrieved test record to disclose, based on the member identifier, that a response was received from a list member associated with the member identifier.
23. The apparatus of claim 22, wherein the test database contains a question identifier and an answer identifier.

24. The apparatus of claim 14, wherein instructions to select a postal mailing list from the plurality of postal mailing lists include instructions to:
- determine the response rate of each of the plurality of postal mailing lists; and
 - select the postal mailing list with the highest response rate.
25. The apparatus of claim 14, wherein said receiving responses includes detecting the use of a URL embedded in the e-mail message.
26. The apparatus of claim 14, wherein a list member associated with a received response is compensated for the response.
27. A medium storing instructions adapted to be executed by a processor to provide a mailing list test service for a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member, said instructions comprising:
- (a) sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;
 - (b) receiving a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from one of the subsets of list members; and
 - (c) selecting for use, based on the responses received in (b), one of the plurality of postal mailing lists.
28. The medium of claim 27 storing further instructions adapted to be executed by a processor, said further instructions comprising:
- (d) selling the postal mailing list selected in (c).
29. The medium of claim 27 storing further instructions adapted to be executed by a processor, said further instructions comprising:
- (d) renting to another the postal mailing list selected in (c).

30. The medium of claim 27 storing further instructions adapted to be executed by a processor, said further instructions comprising:

(d) mailing information via post to members of the postal mailing list selected in (c).

31. The medium of claim 27, wherein the instructions to send an e-mail message in (a) include further instructions adapted to be executed by a processor to:

(i) send, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and

(ii) send, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset,

wherein the first e-mail message includes content different from the second e-mail message.

32. The medium of claim 31, said medium storing further instructions adapted to be executed by a processor to store the responses received in (b).

33. The medium of claim 31, wherein one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of content, and wherein said selecting in (c) includes selecting one of the plurality of postal mailing lists based on mailing list content in the e-mail messages sent in (a).

34. The medium of claim 33, wherein said selecting in (c) further includes:

(i) determining a response rate of each of the plurality of postal mailing lists; and

(ii) selecting the postal mailing list that has a response rate higher than the response rate of the other postal mailing lists.

35. The medium of claim 27, wherein each response received in (b) includes a test identifier and a member identifier, and wherein the medium includes further instructions adapted to be executed by a processor, said further instructions comprising:

(d) retrieving a test record from a test database based on the received test identifier; and

(e) marking the retrieved test record to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.

36. The medium of claim 35, wherein said instructions to receive a response to the e-mail message include instructions to:

(i) receive a question identifier; and

(ii) receive an answer identifier.

37. The medium of claim of claim 36, wherein the selection in (c) includes selecting based on the received question identifier and the received answer identifier.

38. The medium of claim 27, wherein said instructions to select a postal mailing list include instructions to:

(i) determine the response rate of each of the plurality of postal mailing lists; and

(ii) select the postal mailing list that has the highest response rate.

39. A system for providing a mailing list test service involving a plurality of postal mailing lists, each postal mailing list including information about a plurality of list members, the information including a postal address for each list member, the system comprising:

(a) means for sending, for each postal mailing list in the plurality of postal mailing lists, an e-mail message to each of a subset of list members;

(b) means for receiving a plurality of responses, each received response corresponding to an e-mail message sent in (a), each received response being associated with a list member from one of the subsets of list members; and

(c) means for selecting for use, based on the responses received in (b), one of the plurality of postal mailing lists.

40. The system of claim 39, further comprising:

(d) means for selling the postal mailing list selected in (c).

41. The system of claim 39, further comprising:

(d) means for renting to another the postal mailing list selected in (c).

42. The system of claim 39, further comprising:

(d) means for mailing information via post to list members of the postal mailing list selected in (c).

43. The system of claim 39, wherein said means for sending an e-mail message in (a) includes:

(i) means for sending, for a first postal mailing list in the plurality of postal mailing lists, a first e-mail message to a first member of the subset; and

(ii) means for sending, for the first postal mailing list in the plurality of postal mailing lists, a second e-mail message to a second member of the subset, wherein the first e-mail message includes content different from the second e-mail message.

44. The system of claim 39, further comprising:

(d) means for storing the received responses.

45. The system of claim 44, wherein one of the plurality of postal mailing lists contains a first set of mailing list content, and another of the plurality of postal mailing lists contains a second set of mailing list content, and wherein said means for selecting includes means for selecting one of the plurality of postal mailing lists based on mailing list content included in sent computer based messages.

46. The system of claim 45, wherein said means for selecting further includes:

(i) means for determining a response rate of each of the plurality of postal mailing lists; and

(ii) means for selecting the postal mailing list that has a response rate higher than the response rate of the other postal mailing lists of the plurality of postal mailing lists.

47. The system of claim 39, wherein each response received in (b) includes a test identifier and a member identifier, and further comprising:

(d) means for retrieving a test record from a test database based on the received test identifier; and

(d) means for marking the retrieved test record to disclose, based on the received member identifier, that a response was received from a member associated with the member identifier.

48. The system of claim 47, wherein the responses received in (b) further include a question identifier and an answer identifier.

49. The system of claim 48, wherein said means for selecting one of the plurality of postal mailing lists includes means for selecting based on the received question identifier and the received answer identifier.

50. The system of claim 49, wherein said means for selecting one of the plurality of postal mailing lists includes:

(i) means for determining a response rate of each of the plurality of postal mailing lists; and

(ii) means for selecting the postal mailing list that has the highest response rate.

APPENDIX B

CHART SHOWING CLAIM DEPENDENCIES

Claims 1 – 50 are pending and appealed. Claims 1, 14, 27, and 39 are independent.

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CHART SHOWING CLAIM DEPENDENCIES